



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HAMILTON &
TERRILE, LLP
IBM AUSTIN
P.O. BOX 203518
AUSTIN TX 78720

COPY MAILED

MAR 16 2010

In re Application of :
Benatar, et al. :
Application No. 09/821,081 : DECISION
Filed/Deposited: 29 March, 2001 :
Attorney Docket No. AUS920010141US1 :

This is a decision on the petition filed on 2 October, 2006, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR §1.137(b)."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

The history of this matter is confused, at best, and most certainly unexplained in that there is no information in the record that suggests the "how" or the "why" as to:

- *the delay between the non-final Office action (September 2004) and the abandonment (December 2004);*
- *the delay between the abandonment and/or the Notice of Abandonment (April 2005) and the filing of a petition to revive (October 2006);*
- *the possible failure to properly file the petition so as to flag the matter for consideration by the Office of Petitions; and*
- *the failure to file even a single Status Inquiry in this matter delay between the filing of a petition to revive and mid-March 2010.*

Petitioner's duty on any renewed petition is to set forth the facts surrounding the matter and support those facts with documentary evidence.

*Moreover, should it occur that the practitioner now attending to this matter be one other than those involved in the events set forth above, Petitioner **must** provide statements from the proper persons involved in those events. Failing that, Petitioner must document a showing of proper and diligent inquiry before submitting further materials to the Office.*

In any case, Petitioner is reminded that the Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel when accepting Petitioner's representation (including Petitioner's submission of supporting documentation) that the delay in filing the response was unintentional.¹

It was and remains Petitioner's duty to properly docket this and other matters to ensure that a Status Inquiry is timely and properly filed when Petitioner finds that no reply to Petitioner's submission(s) has been received from the Office.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that Petitioner has not satisfied the statement/showing (as to the nature of the delay) requirements pursuant to the regulations at 37 C.F.R. §1.137(b).

BACKGROUND

The record reflects as follows:

Petitioner/former Counsel failed to reply timely and properly to the non-final Office action mailed on 30 December, 2004, with reply due absent and extension of time on or before 30 December, 2004.

The application went abandoned by operation of law after midnight 30 December, 2004.

¹ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. ' 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. ' 1.137(b) to the Patent and Trademark Office).

The Office mailed the Notice of Abandonment on 18 April, 2005.

On 2 October, 2006, Petitioner/former Counsel filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b) with fee, and a reply in the form of an amendment and made a statement of unintentional delay, but it is impossible from the current state of the record to determine who has been in control of the application in the interim and who now is in control of the application. Moreover, it appears that:

- the petition may have been electronically submitted and improperly coded; and
- there has been absolutely no inquiry into this matter in the forty-one (41) months since the petition was filed.

Should Petitioner wish to object that telephone inquiries were made in the matter, Petitioner is reminded that that all practice before the Office is in writing (see: 37 C.F.R. §1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

These matters must be addressed and documented on any renewed petition.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{4, 5}

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

⁴ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁶ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.